

RECEIVED
CENTRAL FAX CENTER

AUG 29 2006

10/660,754
DOCKET NO. K06-161131M/TBS

8

REMARKS

Claims 1-4, 11-14, 40-44, 46-47, and 50-55 are all the claims presently pending in the application. Applicants gratefully acknowledge the Examiner's indication of allowability of claims 1-4, 11-13, 40-44, 46-47, and 50-52, if the § 112, second paragraph rejection is overcome. These are no prior art rejections. The specification and claims 1 and 50 are amended to more clearly define the invention and claim 45 is canceled. Claims 1 and 50 are independent.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Entry of this §1.116 Amendment is proper. Since the Amendments above narrow the issues for appeal and since such features and their distinctions over the prior art of record were discussed earlier, such amendments do not raise a new issue requiring a further search and/or consideration by the Examiner. As such, entry of this Amendment is believed proper and Applicant earnestly solicits entry. No new matter has been added.

I. THE NEW MATTER OBJECTION

The Office Action objects to the May 1, 2006, Amendment for allegedly introducing new matter into the disclosure. Applicants respectfully traverse this objection and submit that the Amendment does not introduce new matter.

In particular, the Office Action alleges that Figure 2 does not support the amendment because Figure 2 is particular to the race portion 2c, not the shoulder portions.

While Figure 2 is particular to the race portion 2c, the specification constantly, consistently, and repeatedly makes it clear that the race portions and the shoulder portions are subjected to roller burnishing. The originally filed disclosure constantly, consistently, and repeatedly explains that "the race portions 2c and 4a and the shoulder portion 2d are subjected to roller burnishing." (Emphasis added, Page 8, lines 18-20; et. seq.). The specification further makes it clear that Figure 2 presents the results of verifying tests of that roller burnishing as an example. "Here, a specific explanation will be given of operation and effect of the roller burnishing in reference to Fig. 2 and Fig. 3 showing an example of a result

10/660,754

9

DOCKET NO. K06-161131M/TBS

of a verifying test which has been carried out by the inventors and the like of the invention.”
(See pages 9, line 10, through page 11, line 22).

In other words, the specification constantly, consistently, and repeatedly makes it clear that roller burnishing is applied to the race portions and the shoulder portions and that Figure 2 merely illustrates an example of the results of such roller burnishing. The specification constantly, consistently, and repeatedly makes it clear that the effects of the roller burnishing on the race portions are the same as the effects on the shoulder portions because the same roller burnishing that is applied to the race portions are applied to the shoulder portions.

Applicants respectfully request withdrawal of this objection.

II. THE DRAWING OBJECTION

The Office Action objects to Fig. 2 because allegedly the “lead line for the shot-peened product points not to the shot-peened product curve, but instead to the roller burnished product curve.” Applicants respectfully traverse this objection.

Figure 2 includes three curves. The first curve is a solid-line curve to which a solid-lead line leads from the “Pre-roller burnished product” reference. The second curve is a dashed-line curve to which a dashed-line leads from the “Roller Burnished Product” reference. The third curve is an intermittent-dashed line curve to which an intermittent-dashed lead line leads from the “Shot-peened product” reference. All of the lead lines point to the correct curves.

Applicants respectfully request withdrawal of this objection.

III. THE SPECIFICATION OBJECTION

The Office Action objects to the specification for failing to provide “proper antecedent basis for the subject matter of claims 41 & 42.” While Applicants submit that such would be clear to one of ordinary skill in the art to allow them to know the metes and bounds of the invention, taking the present Application as a whole, to speed prosecution the specification has been amended to “provide antecedent basis” in accordance with Examiner Binda’s very helpful suggestions.

In view of the foregoing, the Examiner is respectfully requested to withdraw this

10/660,754
DOCKET NO. K06-161131M/TBS

10

objection.

IV. THE 35 U.S.C. § 112, FIRST PARAGRAPH REJECTION

The Office Action rejects claims 14, 45, and 53-55, as allegedly not being supported by the original disclosure. Applicants respectfully traverse this rejection.

With respect to claim 14, the Office Action alleges that there does not appear to be a written description of the limitations of claim 14 as originally filed.

However, contrary to the Examiner's allegations, and as explained above, the specification makes it very clear that the race portions and the shoulder portions are subjected to roller burnishing. Figure 2 is merely provided as evidence of the results of such roller burnishing. While Figure 2 illustrates the results of such roller burnishing on a race portion, those of ordinary skill in the art understand that the race portion merely provides an example of the effects of such roller burnishing, and that the same effects are provided to the shoulder portions because the shoulder portions are also roller burnished.

With respect to claims 53-55, the Office Action alleges that there does not appear to be a written description of the limitations of claims 53-55 as originally filed.

In this regard, there is no requirement that the written description must include a description of all claim limitations as originally filed.

Rather, there is only a requirement that the specification (which includes the drawings) as originally filed provides support for the claim limitations such that it is clear that the inventors had possession of the invention.

In this regard, the specification (which includes the drawings) as originally filed supports the features recited by claims 53-55 at, for example, Figure 3.

Further, since the Examiner has rejected claims 53-55, under 35 U.S.C. 112, first paragraph as failing to provide a written description, the written description has been amended to describe the features which are illustrated by Figure 3 and recited by claims 53-55. Applicants appreciate Examiner Binda's suggestion in this regard.

Applicants respectfully request withdrawal of these rejections.

V. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 1-4, 11-14, 40-47, and 50-55 are indefinite. While Applicant submits that such would be clear to one of ordinary skill in the art to allow them to

10/660,754
DOCKET NO. K06-161131M/TBS

11

know the metes and bounds of the invention, taking the present Application as a whole, to speed prosecution claims 1 and 50 have been amended in accordance with Examiner Binda's very helpful suggestions.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

VI. FORMAL MATTERS AND CONCLUSION

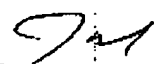
In view of the foregoing amendments and remarks, Applicants respectfully submit that claims 1-4, 11-14, 40-44, 46-47, and 50-55, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 8/29/06


James E. Howard, Esq.
Registration No. 39,715

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Rd., Suite 200
Vienna, Virginia 22182
(703) 761-4100
Customer No. 21254

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment After-Final Rejection Under 37 CFR §1.116 by facsimile with the United States Patent and Trademark Office to Examiner Gregory John Binda, Group Art Unit 3679 at fax number (571) 273-8300 this 29th day of August, 2006.


James E. Howard, Esq.
Registration No. 39,715